REMARKS

I. Claims 1-9, 11, 13-23, 25-28, 33 and 90

A. "Rules" are different from "States"

In rejecting claims 1-9, 11, 13-23, 25-28, 33 and 90 as anticipated by *Tang et al* (US Pat 5,793, 365), the Examiner appears to suggest that a "rule" and a "state" are the same thing.[1] In particular, the Examiner explains that:

> The user or the system decides the states/rules. If the user sets his/her activity as unavailable, then for the second/third party etc, the first user (targeted user) will appear unavailable, hence a rule has been set by the first user [].

This characterization is inaccurate. One of ordinary skill in the art would readily recognize the ordinary meaning of a "rule" as being different from that of a "state." One of ordinary skill in the art would immediately recognize that a rule causes certain actions to occur. A state does not.

"Rules" and "states" are often related. For example, in Applicant's FIG. 6, one sees a dialog box that shows certain actions (towards the bottom of the dialog box) that occur when certain states (the middle section of the dialog box) occur.

When a user enters one of *Tang*'s "states," nothing triggers a particular action. For example, in *Tang,* a user in an "attentive" state can execute all the

---

[1] 11/16/2007 Office Action, p. 18, in which the Examiner characterizes the "rule[s] created by [a] person" of claim 1 as *Tang*'s "states of the user."

same actions as a user in a "do not disturb" state.[2] *Tang* even describes its "states" as mere "<u>social cues</u> for establishing . . . interactions."[3] But *Tang* fails to ever describe these "social cues" as anything more than the software equivalent of hanging a "do not disturb" sign on a door. There is nothing in Tang that suggests that entry into a particular state causes an action to occur.

B. Tang fails to teach a communication mode determined by a rule

Additionally, claim 1 requires that a "mode [of communication]" be "determined by a rule."

The Examiner cites to two passages of *Tang* as allegedly teaching this step. This first passage (col. 5, lns. 55-67 and col. 6, lns. 10) describes the user's "states," as previously discussed. This passage fails to even mention any modes of communication. Instead, it focuses on the user's activity level. Therefore, this passage not only fails to describes "a rule" but also fails to describe a "communication mode" as being "determined by the rule."

The second passage that allegedly teaches the foregoing limitation consists of two claims (col. 15, claims 1 and 2). Both of these claims fail to teach a mode of communication that is in any way determined by a rule. With regard to communication modes, *Tang* claim 1 states:

> at least one communication service accessible from the
> user interface display, and capable of establishing a
> communication link between a first computer of the first
> user and at least one computer of a second user in
> response to a first input by the first user selecting the at
> least one second user

---

[2] *Tang*, col. 5, ln. 59 and col. 6, ln. 4.
[3] *Tang*, col. 4, lns. 53-53

However, this claim fails to describe how the communication mode is selected. The only "selection" referred to in this claim is the selection of a second user by a first user. Clearly, a "second user" is a person, not a "communication mode," and a "first user" is a person, not a "rule." Therefore, a disclosure of a first person selecting a second person is not the same as a disclosure of a rule determining a communication mode.

Tang's claim 2 requires:

> at least one communication service accessible from the
> user interface display, and capable of establishing a
> communication link between a first computer of the first
> user and a computer of at least one second user in
> response to a first input by the first user in the user
> interface display selecting the visual representation of at
> least one second user

While Tang's claim 2 discloses having a user select "the visual representation" of another user, it doesn't mention selecting the <u>mode of communication</u>, let alone selecting the mode using a rule created by a user.

Even if one were to accept one of *Tang's* "states" as being some sort of "rule," *Tang* fails to describe how a state selects a mode of communication. For example, the two passages cited as allegedly teaching this limitation fail to specify how the mode of communication is determined when the user state is "attentive" or "do not disturb."

Claim 1 also requires that the mode of communication be selected "by a rule created <u>by the second person</u>," where the second person is the party with whom another person ("a first person") wants to converse. *Tang* clearly fails to teach this limitation. Instead, in *Tang*, the mode of communication is selected by either the first person or by a machine. In particular, *Tang* states:

> In a preferred embodiment, the communication server 80
> selects the highest communication service available on both
> computers 101, which is typically video-conferencing. . . .
> In an alternate embodiment, the user selects the
> communication service level directly. (col. 14, lns. 40-58).

In the above passage, "the user" refers to a first person, because the user
was previously defined as the person initiating the communication.[4]

Claims 18 and 33 are patentable for at least similar reasons as claim 1. All
of the dependent claims are patentable for at least the reasons for which the claims
on which they depend are patentable.

II. Claim 89

Claim 89 has been amended. Claim 89 is patentable for at least similar
reasons as claim 1.

III. Claims 10, 24 and 29-32

Claims 10, 24 and 29-32 have been rejected as being rendered obvious by
the combination of *Tang* and *Rudy et al* (US Pat 6,360,252).

The applicant respectfully disagrees with these rejections. As discussed
above, *Tang* fails to teach the method of claims 1 and 18. Claims 10, 24 and 29-
32 either depend on claim 1 or claim 18. As such, even if one were to somehow
combine *Tang* and *Rudy*, the result would still fail to teach all the limitations of
claims 10, 24 and 29-32.

---

[4] *Tang*, col. 14, lines 20-21 "The user double clicks 701 an icon 14 displayed in the gallery
window 10.".

Moreover, the examiner has failed to identify any reason to combine *Tang* and *Rudy*.[5] A prima facie case of obviousness requires more than simply identifying claim elements scattered among various prior art references. In addition, the Examiner must articulate some reason to combine the references.[6]

Additionally, with regard to claim 29, the applicant respectfully disagrees that *Rudy* (col. 26, lns. 20-24) teaches "the switched local area network is configured to connect to an internet protocol/public switched telephone network gateway." Instead, *Rudy* simply states that:

> For example, client machines could include remote or
> mobile devices such as cellular telephones, pagers,
> landline display screen telephones, set-top boxes, general
> purpose computers, and so forth.

IV. Claim 12

Claim 12 has been rejected as being rendered obvious by the combination of *Tang* and *Malik* (US Pub 2004/0078443),

The applicant respectfully disagrees with this rejection. As discussed above, *Tang* fails to teach the method of claim 1. Claim 12 depends on claim 1. As such, even if one were to somehow combine *Tang* and *Malik*, the result would still fail to teach all the limitations of claim 12.

Moreover, the examiner has failed to identify any reason to combine *Tang* and *Malik*. A prima facie case of obviousness requires more than simply

---

[5] *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1731 (2007) ("[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.").
[6] *Id.* ("A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.").

Applicant : Randall Frank et al.   Attorney's Docket No.: 08575-088001
Serial No. : 10/728,374
Filed   : December 4, 2003
Page   : 14 of 14

identifying claim elements scattered among various prior art references. In addition, the Examiner must articulate some reason to combine the references.

V. Summary

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

No fees are believed to be due in connection with the filing of this request for reconsideration. However, to the extent fees are due, or if a refund is forthcoming, please adjust our deposit account 06 1050 referencing attorney docket "08575-088001."

Respectfully submitted,

Date: January 16, 2008   /Faustino A. Lichauco/
                                        Faustino A. Lichauco
                                        Reg. No. 41,942

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

droa-08575-088001 (2).doc